

## REMARKS

Applicant has made the above amendments and offers the below remarks in support of the patentability of the pending claims in this application.

### **Status of the Claims**

By this Amendment, claim 32 has been canceled without prejudice or disclaimer and claims 16, 21, 31, and 33 have been amended. No new matter has been added. Claims 1-31 and 33-36 are now present in this application. Of those claims, claims 4, 5, 8, 12-15, 19, 20, 23, and 27-30 stand withdrawn from consideration as being directed to non-elected subject matter. Thus, claims 1-3, 6, 7, 9-11, 16-18, 21, 22, 24-26, 31, and 33-36 are currently pending on the merits.

### **Amendments to the Claims**

Applicant has amended independent claim 16 to recite "a fluid source" and "a baby's mouth" rather than "the fluid source" and "the baby's mouth." Applicant has amended dependent claim 21 to recite "a nipple," instead of "the nipple." Applicant has amended claim 31 to incorporate the recitation of claim 32 of "drawing fluid from a fluid source into the first pathway and the second pathway," and accordingly canceled claim 32. Claim 33 has been amended to depend from claim 31, instead of now canceled claim 32. In light of at least the support found in the original specification and the nature of the amendments, Applicant submits that the amendments do not add any prohibited new matter and that the skilled artisan would readily understand Applicant to have been in possession of the claimed subject matter at the time this application was filed. Thus, Applicant requests that the Office enter the amendments without objection or rejection.

### **Objection to the Specification**

The Office objected to Applicant's previous amendment to paragraph [079] in its Response to Office Action filed March 24, 2008, as not legible and unclear as to the amended part of the equation. See Office Action at 2.

Applicant submits that the amendment to the specification at paragraph [079] was made merely to correct an obvious typographical error (i.e., the equation number in the right margin "[6]" was missing in the originally-filed application). That amendment

has been re-submitted herein. That amendment does not add new matter and Applicant respectfully requests that the amendment be entered accordingly without objection or rejection.

**Rejection under 35 U.S.C. § 112**

The Office rejected claims 16 and 21, and consequently all dependent claims therefrom, under 35 U.S.C. § 112 as allegedly indefinite for failing to point out and distinctly claim the subject matter regarded as the invention. See Office Action at 2. Specifically, the Office objected to the recitations of “the fluid source” and “the baby’s mouth” in claim 16 and the recitation of “the nipple” in claim 21, for allegedly lacking antecedent basis. *Id.* Applicant has amended the recitations “the fluid source” and “the baby’s mouth” in claim 16 to recite “a fluid source” and “a baby’s mouth.” Similarly, in claim 21, Applicant has amended “the nipple” to recite “a nipple.” As such, Applicant submits that the Office’s rejections regarding improper antecedent basis have been obviated, and respectfully requests that they be withdrawn.

**Rejection under 35 U.S.C. § 102(b)**

The Office rejected claims 31-33 and 36 under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 3,790,016 to Kron (“*Kron*”). See Office Action at 2-3. The Office asserts that *Kron* discloses a method of indicating suction from a baby’s suckling, comprising: receiving suction from the baby’s mouth; providing the suction to at least a first pathway and a second pathway separate from the first pathway; and indicating in the second pathway the presence of the suction. See Office Action at 3. Applicant respectfully traverses the rejection.

Amended claim 31, and by virtue of dependency claims 33 and 36, are not anticipated by *Kron* for at least the reason that *Kron* fails to disclose a method including both providing suction from a baby’s mouth to at least a first pathway and a second pathway separate from the first pathway and drawing fluid from a fluid source into the first pathway and the second pathway. As amended herein, claim 31 recites:

A method of indicating suction from a baby’s suckling, comprising:  
receiving suction from a baby’s mouth;  
providing the suction to at least a first pathway and a second  
pathway separate from the first pathway;  
drawing fluid from a fluid source into the first pathway and the

second pathway; and  
indicating in the second pathway the presence of the suction.

The Office has cited Figure 1 of *Kron* as support for the recitation "providing the suction to at least a first pathway and a second pathway separate from the first pathway," and Figure 6 of *Kron* for support for the recitation (previously in claim 32) "drawing fluid from a fluid source into the first pathway and the second pathway." See Office Action at 3. However, Applicant respectfully notes that Figures 1 and 6 of *Kron* are separate and distinct embodiments that operate in different ways and perform different functions. While in Figure 1 both pathways may receive suction from a baby's mouth, and in Figure 6 both pathways draw fluid from a fluid source, in neither Figure 1 nor Figure 6 does the singular disclosed embodiment both provide suction from a baby's mouth to at least a first pathway and a second pathway separate from the first pathway and draw fluid from a fluid source into the first pathway and the second pathway, as recited in pending claim 31. As such, Applicant respectfully requests that the rejection under 35 U.S.C. § 102(b) be withdrawn, and pending claims 31, 33, and 36 be passed to allowance.

Moreover, Applicant notes that if either embodiment of Figure 1 or Figure 6 were to be modified to include both of those features, the purpose of each embodiment would be destroyed. Such a modification reveals that the skilled artisan would not have been motivated or found it desirable to have made such a modification in an attempt to achieve the subject matter of the pending claims, thus demonstrating that the claims are also not obvious over *Kron*. See MPEP § 2143.01(V). As such, even though it has not been alleged by the Office, Applicant respectfully submits that *Kron* does not render obvious the pending claims of this application.

**Rejection under 35 U.S.C. § 103(a)**

The Office rejected dependent claim 34 under 35 U.S.C. § 103(a) as allegedly obvious over *Kron* in view of U.S. Patent No. 5,263,599 to Sklar ("*Sklar*") and dependent claim 35 under 35 U.S.C. § 103(a) as allegedly obvious over *Kron* in view of U.S. Patent No. 6,741,523 to Bommarito ("*Bommarito*"). See Office Action at 4-5. Regardless of what *Sklar* and *Bommarito* may teach about gradations or color codes, they fail to cure the above-noted deficiencies in *Kron*. As claims 34 and 35 depend on claim 31, they

are thus allowable for at least the reasons explained above. As such, Applicant respectfully requests that the rejections under 35 U.S.C. § 103(a) be withdrawn, and claims 34 and 35 be passed to allowance.

### **Provisional Obviousness-Type Double Patenting Rejection**

The Office provisionally rejected claims 1-3, 6, 7, 9-11, 16-18, 21, 22, 24-26, and 31-36 under the judicially created doctrine of obviousness-type double patenting over claims 1-28 of co-pending U.S. Patent Application No. 11/300,515. See Office Action at 5-6. The Office stated that a timely filed Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c) could be used to overcome this rejection. *Id.* While not necessarily agreeing with the basis of the rejection, Applicant submits herewith a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c). The filing of this Terminal Disclaimer is not in any way an admission by Applicant that the obviousness-type double patenting rejection is proper. See MPEP § 804.02. As such, the rejection should now be obviated and Applicant respectfully requests that it be withdrawn.

### **Conclusion**

For at least the reasons detailed above, Applicant respectfully requests that the rejections against this application be withdrawn and that pending claims 1-3, 6, 7, 9-11, 16-18, 21, 22, 24-26, 31, and 33-36 be passed to allowance. In addition, each of withdrawn claims 4, 5, 8, 12-15, 19, 20, 23, and 27-30 ultimately depend from allowable independent claim 1 or 16. For at least that reason, claims 4, 5, 8, 12-15, 19, 20, 23, and 27-30 should also be allowable. Therefore, Applicant also respectfully requests rejoinder and allowance of withdrawn claims 4, 5, 8, 12-15, 19, 20, 23, and 27-30.

Applicant notes that the Office Action contains a number of assertions concerning the cited art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicant declines to automatically subscribe to them.

If the Office has any questions regarding this Response or the application in general, Applicant respectfully requests that the Office contact the undersigned representative at the information listed below.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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